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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,859	05/14/2009	Massimo Losio	374-45	1425
24336	7590	03/22/2012	EXAMINER	
TUTUNJIAN & BITETTO, P.C.			PATTERSON, MARIE D	
425 Broadhollow Road, Suite 302			ART UNIT	PAPER NUMBER
Melville, NY 11747			3765	
			MAIL DATE	DELIVERY MODE
			03/22/2012	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/598,859	LOSIO, MASSIMO
	<b>Examiner</b>	<b>Art Unit</b>
	MARIE PATTERSON	3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 2/23/12.
- 2a)  This action is **FINAL**.                            2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5)  Claim(s) 1,3-9,11-13 and 15-20 is/are pending in the application.
  - 5a) Of the above claim(s) 13 and 15-20 is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1,3-9,11 and 12 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on 23 February 2012 is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \*    c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3-9, 11, and 12, drawn to a footwear insole, classified in class 36, subclass 44.
  - II. Claims 13 and 15-20, drawn to a method of manufacturing a footwear insole, classified in class 264, subclass ?.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the insole could be made by providing an insole and providing a sheet of gel, cutting the gel or forming the gel to the size and shape of the heel portion and adhesively connecting the gel sheet element to the insole, i.e. without the use of molds, co-molding, or molding the gel onto an insole.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply: while the searches may overlap the search would be burdensome and longer because the examiner would need to search for each distinct inventions or variations. Furthermore, the search is only part of the examination process, the MPEP 803 states "If the search and examination of all the

claims in an application can be made without serious burden". The examination of the application would be burdensome because the examiner would be required to apply art and rejections to the additional claims directed towards each distinct and different invention.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Newly submitted claims 13 and 15-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the insole could be made by providing an insole and providing a sheet of gel, cutting the gel or forming the gel to the size and shape of the heel portion and adhesively connecting the gel sheet element to the insole, i.e. without the use of molds, co-molding, or molding the gel onto an insole. (See restriction laid out in the above paragraphs)

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13 and 15-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is confusing, vague, and indefinite because no such appendage has been shown and therefore it is not clear what structural limitations applicant intends to encompass with such language.

***Drawings***

7. The drawings were received on 2/23/12. These drawings are not entered because they contain new matter. There is no basis in the original drawings for the specific shape, size, location of the rear portion shown in figure 6, specifically element 501.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the insole claimed in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

9. The amendment filed 2/23/12 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: there is no basis in the original specification for the element 501 now shown in the drawings and referred to in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4, 5, 7-11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain (2004425) in view of Hardt (6598319).

Bain shows an insole comprising a front portion (A) and a rear cushioning portion (D) substantially as claimed except for the material for the front portion and cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24) and teaches the use of transpiring materials (42) for a front portion. It would have been

obvious to use gel and transpiring materials as taught by Hardt for the materials for the insole of Bain to provide increased comfort and cushioning.

In reference to claims 5, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use "varnish" or any other materials known for reducing tackiness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In reference to claim 12, Hardt teaches providing a metatarsal insert (26). It would have been obvious to provide additional inserts such as a metatarsal insert as taught by Hardt in the insole of Bain to increase comfort and cushioning.

12. Claims 1, 5, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (2862313) in view of Hardt (6598319).

Jones shows an insole comprising a transpiring (leather) front portion (10) and a rear cushioning portion (16), and a metatarsal cushionin portion (14, 15, and 17) substantially as claimed except for the material for the cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24). It would have been obvious to use gel as taught by Hardt for the materials for the cushioning elements of Jones to provide increased comfort and cushioning.

In reference to claim 5, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use “varnish” or any other materials known for reducing tackiness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

13. Claims 1, 5-7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver (2083581) in view of Hardt (6598319).

Silver shows an insole comprising a transpiring (leather) front portion (11) and a rear cushioning portion (26), and a metatarsal cushionin portion (19) substantially as claimed except for the material for the cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24). It would have been obvious to use gel as taught by Hardt for the materials for the cushioning elements of Silver to provide increased comfort and cushioning.

In reference to claim 5, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use “varnish” or any other materials known for reducing tackiness, since it has been held to be within the general skill of a worker in

the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Response to Arguments***

14. Applicant's arguments filed 2/23/12 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the use of gels not being obvious in full width cushioning elements or for cushioning elements which are cemented in place, the Examiner has cited references Harb (2005/0144811) and Lebo (2006/0277799) which clearly show the well known and conventional use of gel sheets/plugs/cushioning elements (34 or 44) which are secured to non gel, non cushioning portions of an insole by the use of cements/adhesives and these gel sheets/plugs/cushioning elements are shown as extending across the width or extending to edge portions of the insole. In view of the well known and conventional use of gel cushion layers which are adhesively connected, applicants' arguments are not persuasive. It is also noted that Hardt clearly suggests placing gel plugs into position and then press fitting or placing cut out gel plugs into position and then attaching such (see column 5 lines 5-15) and therefore is clearly not limited to a liquid gel placed into the cut out area.

In response to applicants' arguments directed towards the use of gel in Bain, Bain clearly suggests the use of a cushioning material in the heel region which is shaped as claimed. The use of a gel material for the cushioning material in the insole of Bain would clearly provide the functions desired by Bain in that the cushion would provide the

benefits desired by Bain, i.e. cushioning of the heel and it inherently would prevent the heel of the wearer contacting the tacks inasmuch as the rubber material explicitly suggested by Bain would.

In response to applicants' arguments directed towards the insole having no discontinuities, it is noted that the claim language states "said gel material having an upper surface for interacting with the heel that has no discontinuities" and the prior art does teach that the gel material portion has a smooth and continuous upper surface.

In response to applicants' arguments directed towards the rejection of claim 5, it is noted that the term "varnish" is defined as a "resin dissolved in a liquid for applying on wood, metal, or other materials to form a hard clear, shiny surface when dry" (google definitions) and it is not clear how "varnish" would function as desired by applicant, i.e. the hard layer would negate the cushioning function of the gel pad. Since applicant did not provide any details as to what materials are encompassed by the term "varnish" which is conventionally a term used to define a plurality of different materials, the Examiner has considered the use of the term to encompass any material which would provide the benefits desired by applicant, i.e. any material used to reduce tackiness. Since this application is a translation from a foreign priority document, the term "varnish" may be in error due to translational issues.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571)273-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Marie Patterson of Art Unit 3765 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

/Marie Patterson/  
Primary Examiner  
Art Unit 3765

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